

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN-IVAR ARVIDSSON

Appeal No. 95-3114
Application 08/051,800¹

HEARD: December 8, 1997

Before CALVERT, COHEN and STAAB, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4, 6, 7, 10 to 12, 15 to 17, 20 to 22, 25 and 26, and from the rejection of claims 3, 5, 8, 9, 13, 14, 18, 19, 23 and 24 in the Supplemental Examiner's Answer (Paper No. 33). No claim is allowed.

¹ Application for patent filed April 26, 1993. According to appellant, this application is a continuation of Application 07/634,131 filed January 4, 1991, now abandoned.

Appeal No. 95-3114
Application 08/051,800

The appealed subject matter concerns a device for fastening a load carrier to the roof of a vehicle. The independent claims on appeal, claims 1, 6, 11, 16 and 21, are reproduced in the appendix hereto.

The references applied by the examiner in the final rejection are:²

Dutschka et al. (Dutschka '718) (German patent)	2933718	Mar. 12, 1981
Morsch (German patent)	3034226	Apr. 15, 1982
Dutschka et al. (Dutschka '424) (German patent)	3018424	May 13, 1982
Rauthmann et al. (Rauthmann) (German patent)	3306360	Sep. 6, 1984
Barbero (European application)	0177758	Apr. 16, 1986
Riehle et al. (Riehle) (Swedish patent)	457073	Nov. 25, 1986
Tittel (European application)	0278435	Aug. 17, 1988

The claims stand rejected as follows:

1. Claims 1, 6 and 21, anticipated by Morsch, Rauthmann or Dutschka '424, under 35 U.S.C. § 102(b);
2. Claims 1, 2, 4, 6, 7, 10 to 12, 15 to 17, 20 to 22, 25 and 26, unpatentable over either of Riehle or Dutschka '718 in view of either Morsch or Rauthmann, under 35 U.S.C. § 103;

² Although appellant and the examiner refer to the references by number, we will for convenience refer to them by the name of the inventor. Translations of the six references which are not in English (all but Barbero), prepared for the PTO, are enclosed herewith.

3. Claims 1, 6 and 21, unpatentable over either of Barbero or Tittel in view of either Morsch or Rauthmann, under 35 U.S.C. § 103;

4. Claims 3, 5, 8, 9, 13, 14, 18, 19, 23 and 24, under 35 U.S.C. § 112, second paragraph.

Rejection 1

In order to constitute an anticipation of a claim under 35 U.S.C. § 102(b), a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, -- F.3d, --, --, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In the present case, looking first at the Morsch reference, we do not find therein a fastening device which is immovably anchored on or fixed to the vehicle, as called for by each of the independent claims, since device (link) 16 is pivoted on rivet 17 (see page 5, lines 5 to 8)³. We do not consider that the device's resting against seal 6 makes it "immovable," as the examiner asserts on page 7 of the answer.

The Rauthmann and Dutschka '424 references likewise do not anticipate the claims because each of them requires, inter alia, that the integrity of the vehicle be modified by making holes in

³ All citations herein to pages and lines of non-English language references are to the translations of the references enclosed herewith.

the roof: in Rauthmann, to accommodate the screws 3 and casings 4, and in Dutschka '424, to pass the lower leg 25 of the device through the roof girder 3 (page 4, lines 13 to 15). These references do not, therefore, disclose a device having an anchorage portion "such that the vehicle need only be modified to the extent that the device [or securement means] is anchored [or fixed] thereto," as recited in each of the independent claims.

Accordingly, the rejections under § 102(b) will not be sustained.

Rejection 2

Riehle in view of Morsch or Rauthmann

Riehle discloses apparatus in which a load carrier 1 is fastened to a vehicle by means of an adapter 4 in a space behind the sealing strip on door 2. Adapter 4 has an engagement member 5, 9 which interconnects with the engagement member 1a of the carrier and will be tensioned when nut 17 on the carrier is tightened (paragraph bridging pages 4 and 5). A neck extends between 5 and the anchorage portion, which, in the embodiment shown in Fig. 4, requires no modification of the vehicle since it constitutes legs 12 hooking onto plate 7 of the vehicle's drip molding (page 4, lines 17 to 20). Appellant argues at page 20 of the brief that the Riehle adapter 4 is not designed to remain

fixed in position on the vehicle after the load carrier is removed, but it is not apparent why it is not. The patent discloses that the Fig. 4 embodiment may have projections on the legs 12, hooking onto plate 7, "so that the connection is even stronger" (id.). This connection would appear to be at least as permanent as appellant's catch-like portion 13, which grips projection 9 on the vehicle.

Riehle does not disclose that the engagement member 5 is "permanently disposed outside the contour of the vehicle," as claimed, but the examiner takes the position that it would have been obvious to so construct the Riehle adapter 4 in view of Morsch or Rauthmann, both of which show adapters which extend upward beyond the roof line of the vehicle.

It seems evident that in designing an adapter of this type, one of ordinary skill would face the choice of whether to make the adapter relatively short (as with the adapter of Riehle), so that it would not project beyond the vehicle contour and thus would preserve the vehicle's aesthetic appearance, or whether to extend the adapter above the vehicle's contour (as with the Morsch and Rauthmann adapters), thereby making it easier to attach the load carrier, and allowing attachment of the carrier without opening the door. Which of these alternatives one of

ordinary skill would adopt would be simply a matter of design choice, depending on which considerations were considered to be more important, and we therefore conclude that it would have been obvious to make the Riehle adapter 4 long enough to project the engagement member 5 above the vehicle contour in view of Morsch's and Rauthmann's disclosure of such adapters.

With regard to claims 2, 7, 12, 17 and 22, we note that legs 12 of Riehle's device 4 surround portion 7 of the vehicle, and the sealing strip on the door appears to bear against the device. On the other hand, we do not find, nor does the examiner point out, where the combination of Riehle and either Morsch or Rauthmann would suggest the additional limitations recited in claims 4, 10, 15, 20, 25 and 26.

This rejection will therefore be sustained as to claims 1, 2, 6, 7, 11, 12, 16, 17, 21 and 22, but not as to claims 4, 10, 15, 20, 25 and 26.

Dutschka '718 in view of Morsch or Rauthmann

Dutschka '718 discloses a device 19 for attaching a load carrier to a vehicle, the device having a hook which engages a pivoted bar 39 on the carrier, and a lower end which is spot welded to the vehicle at 21 (page 4, line 27). The bar 39 is

pivoted to a plate 33 on the carrier such that it would be in tension when clamped.

Appellant, incorrectly assuming that spot welds 21 are rivets, argues that the Dutschka '718 device would require modification of the vehicle, contrary to what is recited in the independent claims. We do not agree. It is fundamental that claims are to be given their broadest reasonable interpretation consistent with the specification, In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969), and must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). In the present case, the only specific reference we find in the specification to modification of the vehicle is the statement on page 2, lines 11 to 18, to the effect that the device of the invention "permits permanent fastening of a clamping unit on the body without any modificational intervention therein." Appellant states on page 3 of the brief that

by providing an anchorage portion that fixes the device only on preexisting portions of the vehicle, the device offers the advantage of avoiding the necessity of diminishing the structural integrity or marring the appearance of the vehicle through the use of special purpose anchorage structures that involve riveting, bolting, welding, or otherwise attaching the devices to a vehicle in a manner that necessitates modifying the vehicle itself.

We agree that diminishing the structural integrity of the vehicle, as by forming holes for the reception of bolts, rivets, etc., would not constitute a modification of the vehicle "only ... to the extent that the device is anchored thereto," as claimed. However, we do not agree that this language would exclude devices that are attached to the vehicle by welding or gluing. Such means of attachment would not diminish the vehicle's structural integrity, nor would it mar the vehicle's appearance any more than would be done by the attachment of any anchorage device, including appellant's.

Accordingly, we conclude that the device 19 of Dutschka '718, being spot welded to the vehicle, has an anchorage portion which anchors the device "such that the vehicle need only be modified to the extent that the device is anchored thereto," as claimed. We further conclude that, for the reasons discussed above, it would have been obvious in view of Morsch or Rauthmann to make the Dutschka '718 device 19 of such length as to extend its engagement member outside the contour of the vehicle.

This rejection of claims 1, 6, 11, 16 and 21 will be sustained. However, it will not be sustained as to claims 2, 4, 7, 10, 12, 15, 17, 20, 22, 25 and 26, each of which recites limitations which would not have been obvious from the

combination of Dutschka '718 and Morsch or Rauthmann, i.e., the device being at least partly fixed in position by cooperation with the masking or sealing strip (claims 2, 7, 12, 17, 22 and 26), or the anchorage portion having a catch-like or catching portion and locking portion (claims 4, 10, 15, 20 and 25).

Rejection 3

The Barbero and Tittel references each disclose devices (Barbero 12, Tittel 26 (Fig. 5)) for attaching a load carrier to a vehicle, the devices being attached to the vehicle by welding or gluing (Barbero, page 3, lines 14 and 15), or by screws 16 (Tittel).

We will sustain the rejection of claim 1, 6 and 21 based on Barbero, but not based on Tittel. Since the Barbero device is welded or glued to the vehicle, it requires modification of the vehicle "only ... to the extent that the device is anchored thereto," whereas the Tittel device requires the drilling of holes in the vehicle for the reception of screws 16 and insert nuts 12. Barbero otherwise meets all the limitations of claims 1, 6 and 21 (being in a space behind a sealing strip 14), except that its engagement member 22 is not disposed outside the contour of the vehicle, but for reasons discussed above, we conclude that

it would have been obvious to so dispose the engagement member in view of Morsch or Rauthmann.

Rejection 4

In the first Office action (Paper No. 5 of application 07/634,131), the examiner required an election of species, in response to which appellant elected the species of Fig. 1 (Paper No. 6, filed Nov. 1, 1991). The examiner indicated that the election had been made with traverse (Paper No. 10, page 2). Thereafter, in the final rejection (Paper No. 26), the examiner stated that claims 3, 5, 8, 9, 13, 14, 18, 19, 23 and 24 were withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected species. In response to arguments in appellant's brief, the examiner held on page 2 of the answer that the question of withdrawal of the claims was a petitionable, not appealable, matter. However, after the appellant, on page 2 of the reply brief, called the examiner's attention to MPEP § 821,⁴

⁴ MPEP § 821 provides

821 Treatment of Claims Held to be Drawn to Nonelected Inventions

* * * * *

The propriety of a requirement to restrict, if traversed, is reviewable by petition under 37 CFR 1.144, *In re Hengehold*, [440 F.2d 1395] 169 USPQ 473 (CCPA 1971).

Appeal No. 95-3114
Application 08/051,800

the examiner then rejected the withdrawn claims under 35 U.S.C. § 112, second paragraph, in the supplemental examiner's answer (Paper No. 33).

After fully considering the arguments presented in the brief, reply brief, response to new grounds of rejection, reply and further reply, as well as the three supplemental examiner's answers, we conclude that the rejection is well taken.

We will discuss claim 3 as being typical of rejected claims 3, 8, 13, 18 and 23; claims 5, 9, 14, 19 and 24 are dependent on these claims, respectively. Claim 3 reads:

All claims that the examiner holds as not being directed to the elected subject matter should be withdrawn from further consideration by the examiner as set forth in MPEP § 809.02(c) and § 821.01 through § 821.03. As to one or more of such claims the applicant may traverse the examiner's holding that they are not directed to the elected subject matter. The propriety of this holding, if traversed, is appealable. Thus, if the examiner adheres to his or her position after such traverse, he or she should reject the claims to which the traverse applies on the ground that they are not directed to the elected subject matter. Because applicant believes the claims are readable on the elected invention and the examiner disagrees, the metes and bounds of the claim(s) cannot be readily ascertained, rendering the claim(s) vague and indefinite within the meaning of 35 U.S.C. 112, second paragraph.

3. The device as claimed in claim 1, wherein the anchorage portions are lamellar and are disposed between a strip and an adjacent portion of the vehicle body, the anchorage portions being fixed in this position by fastening means for the strip which also fasten the anchorage portions in the vehicle body.

Claim 3 requires, first, that the anchorage portions be "lamellar." In interpreting this term, we will give it its "ordinary and accustomed meaning, unless it appears that the inventor used [it] differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). In the specification, the term "lamellar" is used only to describe the anchorage portion 15 of the second embodiment (Fig. 2) (page 3, line 15; page 7, line 36). Anchorage portion 15 is shown in Fig. 2 as a flat piece, and is described on page 8, line 1, as a "sheet strip." This is consistent with the dictionary definition of "lamellar" as "lamellate", i.e., "flat; platelike,"⁵ and it is evident that the Fig. 1 species does not fit this definition, since anchorage portion 13 is not flat, but is bent to grasp projection 9 (page 6, line 29, to page 7, line 1), and has a projecting tongue 14.

Claim 3 also provides that the anchorage portion is fixed in position "by fastening means for the [masking or sealing] strip

⁵ The American College Dictionary (Random House, 1970).

which also fasten the anchorage portions in the vehicle body." There is no disclosure of any such structure for the embodiment of Fig. 1.

On January 28, 1993, appellant filed an amendment adding a new figure, Fig. 4, which appears to show the apparatus of Fig. 1 with the addition of a seal member between the neck 10 and the vehicle, and a screw 18 fastening the neck and seal to the vehicle body. The examiner objected to this amendment as new matter and required cancellation of the added material (final rejection, page 2). She further held this requirement to be petitionable, rather than appealable, noting that the claims have not been rejected as involving new matter⁶ (Paper No. 33, page 2; Paper No. 36, page 2).

We agree with the examiner that the question of new matter, per se, is not before us, since no claims have been rejected on that ground. See MPEP § 608.04(c) and Ex parte Wilcox, 39 USPQ 501, 502 (Bd. App. 1938). Appellant, however, refers to Fig. 4 in arguing that it shows that the species of Figs. 1 and 2 are not mutually exclusive. This argument goes to the propriety of

⁶ While amendatory matter may properly be objected to as new matter under 35 U.S.C. § 132, any rejection on that ground would be under 35 U.S.C. § 112, first paragraph, rather than 35 U.S.C. § 132. See In re Rasmussen, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

the examiner's requiring the election of species in the first place, and as such, addresses a matter which is not within our jurisdiction. In re Watkinson, 900 F.2d 230, 233, 14 USPQ2d 1407, 1409 (Fed. Cir. 1990); In re Hengehold, 440 F.2d at 1404, 169 USPQ at 479-80. Our jurisdiction here is limited to deciding the correctness of the § 112 rejection, i.e., whether claims 3 et al. are readable on the elected species of Fig. 1. For the reasons already discussed above, we conclude that they are not. Moreover, even if Fig. 4 were somehow determined not to be new matter, and part of the elected species, these claims would still not be readable on it because the anchorage portion of Fig. 4 is not "lamellar."

Since claims 3, 5, 8, 9, 13, 14, 19, 23 and 24 are not readable on the elected species, they are indefinite under the rationale set forth in MPEP § 821, supra. The rejection of these claims under 35 U.S.C. § 112, second paragraph, will therefore be sustained.

Conclusion

The examiner's decision

(1) to reject claims 1, 6 and 21 under 35 U.S.C. § 102(b) is reversed;

Appeal No. 95-3114
Application 08/051,800

(2) to reject claims 1, 2, 4, 6, 7, 10 to 12, 15 to 17, 20 to 22, 25 and 26 (a) as unpatentable over Riehle in view of Morsch or Rauthmann is affirmed as to claims 1, 2, 6, 7, 11, 12, 16, 17, 21 and 22, and reversed as to claims 4, 10, 15, 20, 25 and 26, and (b) as unpatentable over Dutschka '718 in view of Morsch or Rauthmann is affirmed as to claims 1, 6, 11, 16 and 21, and reversed as to claims 2, 4, 7, 10, 12, 15, 17, 20, 22, 25 and 26;

(3) to reject claims 1, 6 and 21 (a) as unpatentable over Barbero in view of Morsch or Rauthmann is affirmed, and (b) as unpatentable over Tittel in view of Morsch or Rauthmann is reversed;

(4) to reject claims 3, 5, 8, 9, 13, 14, 19, 23 and 24 under 35 U.S.C. § 112, second paragraph, is affirmed.

Appeal No. 95-3114
Application 08/051,800

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge))	
)	
)	
IRWIN CHARLES COHEN)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
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Appeal No. 95-3114
Application 08/051,800

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APPENDIX

1. A device for fastening one type of load carrier onto a variety of vehicle models, the load carrier being provided with a strut extending transversely over the vehicle roof, a support foot which abuts against the vehicle roof and which transfers thereto the loading of the load carrier, and a clamping unit in the support foot, the clamping unit including an engagement member which, for fixedly securing the load carrier on the vehicle, is movable in a clamping direction substantially transversely of the longitudinal direction of the vehicle, the device comprising a neck portion which is at least partially disposed in a preexisting space behind masking or sealing strips on the vehicle, an anchorage portion for immovably anchoring the device on the vehicle, the anchorage portion being designed for anchoring the device on only preexisting portions of the vehicle such that the vehicle need only be modified to the extent that the device is anchored thereto, and a corresponding engagement member adapted to interconnect with the engagement member such that the corresponding engagement member is placed in tension when the engagement member is moved in the clamping direction, the neck portion, the corresponding engagement member, and at least one part of the anchorage portion being a single, integrated unit, the device being designed to remain fixed in position on the vehicle after removal of the load carrier such that the corresponding engagement member is permanently disposed outside of the contour of the vehicle, the one part of the anchorage portion being designed to be disposed in the preexisting space behind the masking or sealing strips.

6. A device for securing a support foot of one type of load carrier to a variety of vehicle models, comprising:

an engagement member for engagement with a support foot engagement member, the support foot engagement member being movable in a clamping direction substantially transversely relative to a longitudinal direction of the vehicle;

anchorage means for immovably fixing the device to the vehicle, the anchorage means being designed for fixing the device

Appeal No. 95-3114
Application 08/051,800

on only preexisting portions of the vehicle such that the vehicle need only be modified to the extent that the device is fixed thereto;

a neck portion extending between the engagement member and the anchorage means; and

the engagement member of the device being placed in tension when the support foot engagement member moves in a clamping direction, the engagement member of the device being designed to be permanently disposed outside of the contour of the vehicle, and the engagement member of the device, at least a portion of the anchorage means, and the neck portion being a single, integrated unit, the device being designed to remain fixed on the vehicle after removal of the load carrier, the portion of the anchorage means and a part of the neck portion being disposed in preexisting spaces behind a masking or sealing strip of the vehicle.

11. A device for carrying loads on a variety of vehicle models comprising:

a load carrying unit, the load carrying unit including a strut extending over a top portion of the vehicle, a support foot attached to the strut for abutting the top portion of the vehicle, and clamping means in the support foot, the clamping means including a first engagement member, the first engagement member being movable in a clamping direction substantially transversely relative to a longitudinal direction of the vehicle;

securement means for securing the load carrying unit to the vehicle, the securement means including a second engagement member for engaging with the first engagement member and anchorage means for immovably fixing the securement means to the vehicle, the anchorage means being designed for fixing the securement means to only preexisting portions of the vehicle such that the vehicle need only be modified to the extent that the securement means is fixed thereto, and a neck portion extending between the second engagement member and the anchorage means, the second engagement member being designed to be permanently disposed outside of the contour of the vehicle;

the first engagement member being movable to engage with the second engagement member when the first engagement member is moved in the clamping direction, the second engagement member being placed in tension when the first engagement member is moved in the clamping direction, and the second engagement member, at least a portion of the anchorage means, and the neck portion being a single, integrated unit, the securement means being designed to remain fixed to the vehicle after removal of the load carrying unit, the portion of the anchorage means and a part of the neck portion being designed to be disposed in preexisting spaces behind a masking or sealing strip of the vehicle.

16. A vehicle with a disengageable load carrier, comprising:

a vehicle including a sealing or masking strip, the masking or sealing strip defining a space between the masking or sealing strip and a body of the vehicle;

a load carrying unit, the load carrying unit including a strut extending over a top portion of the vehicle, a support foot attached to the strut for abutting the top portion of the vehicle, and clamping means in the support foot, the clamping means including a first engagement member, the first engagement member being movable in a clamping direction substantially transversely relative to a longitudinal direction of the vehicle;

securement means for securing the first engagement member to the vehicle, the securement means including a second engagement member and anchorage means for immovably fixing the securement means to the vehicle, the anchorage means being designed for fixing the securement means on only preexisting portions of the vehicle such that the vehicle need only be modified to the extent that the securement means is fixed thereto, and a neck portion extending between the second engagement member and the anchorage means, the second engagement member being permanently disposed outside of a contour of the vehicle; and

the first engagement member being engageable with the second engagement member when the first engagement member is moved in the clamping direction, the second engagement member being placed in tension when the first engagement member is moved in the

clamping direction, and the second engagement member, at least a portion of the anchorage means, and the neck portion being a single, integrated unit, the securement means being fixed on the vehicle after removal of the load carrying unit, the portion of the anchorage means and a part of the neck portion being disposed in the space between the masking or sealing strip and the vehicle body.

21. A vehicle with a disengageable load carrier comprising:

a vehicle including a masking or sealing strip, the masking or sealing strip defining a space between the masking or sealing strip and a body of the vehicle;

a load carrying unit, the load carrying unit including a support foot and a strut extending over a top portion of the vehicle, and clamping means in the support foot, the clamping means including a first engagement member, the first engagement member being movable in a clamping direction substantially transversely relative to a longitudinal direction of the vehicle;

securement means for securing the load carrying unit to the vehicle, the securement means including a second engagement member and anchorage means for immovably fixing the securement means, the anchorage means being designed for fixing the securement means on only preexisting portions of the vehicle such that the vehicle need only be modified to the extent that the securement means is fixed thereto, the anchorage means including a portion adjacent to and conforming substantially to the shape of a portion of the vehicle, and a neck portion extending between the second engagement member and the anchorage means, the second engagement member being permanently disposed outside of a contour of the vehicle; and

the second engagement member being engageable with the first engagement member when the first engagement member moves in the clamping direction, the second engagement member being placed in tension when the first engagement member moves in the clamping direction, and the second engagement member, at least a portion of the anchorage means, and the neck portion being a single, integrated unit, the securement means being fixed on the vehicle after removal of the load carrying unit, the portion of the

Appeal No. 95-3114
Application 08/051,800

anchorage means and a part of the neck portion being disposed in the space between the masking or sealing strip and the vehicle body.